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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,879	02/11/2004	Said Hilal	ADIV-2321-AL	6407
21378	7590	03/21/2006		
APPLIED MEDICAL RESOUCES CORPORATION 22872 Avenida Empresa Rancho Santa Margarita, CA 92688			EXAMINER VRETTAKOS, PETER J	
			ART UNIT 3739	PAPER NUMBER
DATE MAILED: 03/21/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,879

Applicant(s)

HILAL, SAID

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2-11-04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The application is published application number: 2004/016 7513. The publication is classified in US 606/45.

The Applicant is requested to provide (or check for accuracy) at the beginning of the Specification updated status information (serial numbers and patent numbers) of all related applications. The effective filing date of this application is 1-25-02.

Pending claims as of 2-11-04 are 26-54.

A preliminary amendment was filed 2-11-04.

Independent claims are 26, 36, 43 and 50.

The Office reserves the right to impose a future Restriction requirement. Claim 50 is a separate species from claims 26,36 and 43.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-27, 31-35 and 50-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shattuck et al. (6,387,088).

The teaching reference is silent regarding laser pulsing at multiples governed by the excitation frequency of gas.

However, Shattuck discloses controlling the duration of pulses of energy application for maintaining minimal collateral damage (col. 10:39-42). Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Shattuck by determining the optimal lasing frequency in light of the excitation frequency of gas, (thereby making obvious the Applicant's claims). The motivation to optimize the repetition rate is seen in Shattuck col. 10:32-42.

Note: specific references in the patented disclosure below are not limiting to those excerpts. (The Office reserves the right in future actions to apply other excerpts, need be, from the patent.)

Shattuck makes obvious:

26. An electrosurgical method for performing electrosurgery at an operative site on a patient, comprising the steps of: providing a source of environmental gas molecules having an excitation frequency (obvious by SG – selected gas in figure 5a); moving the gas molecules (SG) from the source into proximity with the operative site (TS); providing

a laser (10-30 in figure 4) having a laser beam (55 in figure 5b) with a frequency equal to about **an integer multiple (obvious through routine experimentation referred in col. 10:35-40 – Shattuck also discloses pulse repetition rate ranges throughout the patent including the claims)** of the excitation frequency of the environmental gas; controlling the laser beam to provide power sufficient to excite (col. 1:48-50) the gas molecules generally along a pathway leading toward the operative site; providing an electrosurgical generator (20) having electrosurgical power; and delivering the electrosurgical power (see figure 5e “electric field”) along the pathway toward the operative site to perform the electrosurgery on the patient (depicted in figures 5c-5e). Also see claim 11.

27. The electrosurgical method recited in claim 26, wherein during the delivering step, includes the step of: providing the electrosurgical energy with power sufficient to ionize the excited gas molecules (col. 11:61) along the pathway. See figures 6a and 6b.

31. The electrosurgical method recited in claim 26, wherein the step of delivering the electrosurgical power includes the step of delivering the electrosurgical power in a monopolar configuration. See col. 11:65-67.

32. The electrosurgical method recited in claim 26, wherein the step of delivering the electrosurgical power includes the step of delivering the electrosurgical power in a bipolar configuration. In the electrosurgical arts, uses of mono-polar and/or bi-polar

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electrode configurations are ubiquitous. As such, disclosure of mono-polar (see claim 31 above) makes obvious disclosure of bi-polar.

33. The electrosurgical method recited in claim 26, further comprising the step of moving (obvious) the laser beam relative to the patient.

34. The method recited in claim 33, wherein the moving step includes the step of scanning (obvious) the laser beam relative to the operative site.

35. The electrosurgical method recited in claim 26, wherein the step of energizing the laser includes the step of pulsing the laser. See col. 9:50-51.

### ***Double Patenting***

The **nonstatutory** double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **terminal disclaimer** in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent

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either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48 of **U.S. Patent No. 6,470,081**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both groups of claims disclose electrosurgical devices with electrodes, lasers and gas supplies.

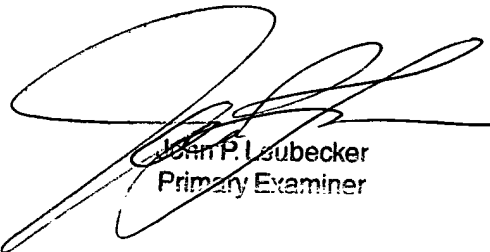
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
March 16, 2006



John P. Laubecker  
Primary Examiner